

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>MAIL STOP PETITION</b>
Seppo HEIMALA et al.	)	Group Art Unit:
Application No.: 10/564,477	)	Examiner:
Filed: January 13, 2006	)	Confirmation No.: 8979
For: METHOD FOR PRODUCING	)	
CONCENTRATES	)	

**PETITION UNDER 37 C.F.R. §1.181 TO VACATE NOTICE OF MISSING  
REQUIREMENTS UNDER 35 U.S.C. §371**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for a decision vacating the Notice of Missing Requirements under 35 U.S.C. §371 in the United States Designated/Elected Office dated May 10, 2006. The Notice states that the current oath or Declaration does not comply with 37 C.F.R. §1.497(a) and (b) since it does not identify the application to which it is directed.

A complete copy of the PCT Request is provided herewith. As may be seen therefrom the Request was prepared using the approved PCT-Safe [EASY mode], Version 3.50 and includes all the required information including the title of the invention, the names of the inventors and the Finnish priority document. After the Declaration section specifically designed for purposes of designation of the United States of America, both of the inventors executed the document in the appropriate locations. Accordingly, it is without question that the standard PCT Request that is executed by the inventors in the appropriate locations fully complies with the Declaration requirements under 37 C.F.R. §1.497(a) and (b). Furthermore, in

accordance with the provisions of MPEP §602, part VI., the information in a Declaration filed with an application that is deemed to be sufficient to identify the application includes the combination of the names of the inventors and the title of the invention which was on the application as filed. As can be seen from the Request and the present application, that is precisely what the document provides. Thus, applicants respectfully submit that the Declaration filed as part of the Request fully complies with the requirements under 37 C.F.R. §1.497(a) and (b) and therefore requests that the Notification of Missing Requirements dated May 10, 2006, be vacated.

Since the action requested herein is to correct a clear error on the part of the United States Patent and Trademark Office, applicants should not be charged a petition fee. However, should a fee be deemed necessary, the fee may be charged to Deposit Account No. 02-4800. A duplicate copy of this document is enclosed.

Should any questions arise concerning the instant matter, the undersigned attorney may be contacted at the number provided below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

By: Robert G. Mukai  
Robert G. Mukai  
Registration No. 28,531

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Alexandria, Virginia 22313-1404  
(703) 836-662

Date: July 10, 2006



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/564,477	Seppo Heimala	1034281-000003

INTERNATIONAL APPLICATION NO.	
PCT/FI04/00451	
I.A. FILING DATE	PRIORITY DATE
07/14/2004	07/17/2003

Buchanan Ingersoll  
 Burns Doane Swecker & Mathis  
 PO Box 1404  
 Alexandria, VA 22313-1404

CONFIRMATION NO. 8979

371 FORMALITIES LETTER



\*OC000000018731441\*

Date Mailed: 05/10/2006

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 01/13/2006
- Copy of the International Search Report filed on 01/13/2006
- Copy of IPE Report filed on 01/13/2006
- Preliminary Amendments filed on 01/13/2006
- Information Disclosure Statements filed on 01/13/2006
- Oath or Declaration filed on 01/13/2006
- Request for Immediate Examination filed on 01/13/2006
- U.S. Basic National Fees filed on 01/13/2006
- Assignment filed on 01/13/2006
- Priority Documents filed on 01/13/2006
- Specification filed on 01/13/2006
- Claims filed on 01/13/2006
- Abstracts filed on 01/13/2006
- Drawings filed on 01/13/2006

RGM

BUCHANAN INGERSOLL PC	
MAY 12 2006	
DOCKETED	5/12/06

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - does not identify the application to which it is directed.

Missing Parts Due: 7/10/06

- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

#### SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Surcharge.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

PAULETTE R KIDWELL

Telephone: (703) 308-9140 EXT 216

#### PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/564,477	PCT/FI04/00451	1034281-000003

**PCT REQUEST**Original (for **SUBMISSION** )

<b>0</b>	<b>For receiving Office use only</b>	
<b>0-1</b>	International Application No.	
<b>0-2</b>	International Filing Date	
<b>0-3</b>	Name of receiving Office and "PCT International Application"	
<b>0-4</b>	<b>Form PCT/RO/101 PCT Request</b>	
<b>0-4-1</b>	Prepared Using	<b>PCT-SAFE [EASY model] Version 3.50 (Build 0002.162)</b>
<b>0-5</b>	<b>Petition</b> The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
<b>0-6</b>	<b>Receiving Office (specified by the applicant)</b>	<b>National Board of Patents and Registration (Finland) (RO/FI)</b>
<b>0-7</b>	<b>Applicant's or agent's file reference</b>	<b>20031036</b>
<b>I</b>	<b>Title of invention</b>	<b>METHOD FOR PRODUCING CONCENTRATES</b>
<b>II</b>	<b>Applicant</b>	
<b>II-1</b>	This person is	<b>applicant only</b>
<b>II-2</b>	Applicant for	<b>all designated States except US</b>
<b>II-4</b>	Name	<b>OUTOKUMPU OYJ</b>
<b>II-5</b>	Address	<b>Riihitontuntie 7 FI-02200 Espoo Finland</b>
<b>II-6</b>	State of nationality	<b>FI</b>
<b>II-7</b>	State of residence	<b>FI</b>
<b>II-8</b>	Telephone No.	<b>+358 9 4211</b>
<b>II-9</b>	Facsimile No.	<b>+358 9 4212978</b>
<b>II-10</b>	e-mail	<b>patent@outokumpu.com</b>
<b>III-1</b>	<b>Applicant and/or inventor</b>	
<b>III-1-1</b>	This person is	<b>applicant and inventor</b>
<b>III-1-2</b>	Applicant for	<b>US only</b>
<b>III-1-4</b>	Name (LAST, First)	<b>HEIMALA, Seppo</b>
<b>III-1-5</b>	Address	<b>Marjastajantie 9 FI-28220 Pori Finland</b>
<b>III-1-6</b>	State of nationality	<b>FI</b>
<b>III-1-7</b>	State of residence	<b>FI</b>

## PCT REQUEST

Original (for SUBMISSION )

<b>III-2</b>	<b>Applicant and/or inventor</b>	
III-2-1	This person is	applicant and inventor
III-2-2	Applicant for	US only
III-2-4	Name (LAST, First)	RUONALA, Mikko
III-2-5	Address	Lumimarjantie 16 FI-28220 Pori Finland
III-2-6	State of nationality	FI
III-2-7	State of residence	FI
<b>IV-1</b>	<b>Agent or common representative; or address for correspondence</b>	
	The person identified below is hereby/ has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	agent
IV-1-1	Name	OUTOKUMPU OYJ, INTELLECTUAL PROPERTY MANAGEMENT
IV-1-2	Address	P.O.Box 27 FI-02201 Espoo Finland
IV-1-3	Telephone No.	+358 9 4211
IV-1-4	Facsimile No.	+358 9 4212978
IV-1-5	e-mail	patent@outokumpu.com
<b>V</b>	<b>DESIGNATIONS</b>	
<b>V-1</b>	<b>The filing of this request constitutes under Rule 4.9(a), the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents.</b>	
<b>VI-1</b>	<b>Priority claim of earlier national application</b>	
VI-1-1	Filing date	17 July 2003 (17.07.2003)
VI-1-2	Number	20031083
VI-1-3	Country	FI
<b>VI-2</b>	<b>Priority document request</b>	
	The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) identified above as item(s):	VI-1
<b>VII-1</b>	<b>International Searching Authority Chosen</b>	Swedish Patent Office (ISA/SE)

**PCT REQUEST**Original (for **SUBMISSION** )

<b>VII-2</b>	<b>Request to use results of earlier search; reference to that search</b>		
<b>VII-2-1</b>	Date	<b>11 May 2004 (11.05.2004)</b>	
<b>VII-2-2</b>	Number	<b>20031083</b>	
<b>VII-2-3</b>	Country (or regional Office)	<b>FI</b>	
<b>VIII</b>	<b>Declarations</b>	<b>Number of declarations</b>	
<b>VIII-1</b>	Declaration as to the identity of the inventor	-	
<b>VIII-2</b>	Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent	<b>1</b>	
<b>VIII-3</b>	Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application	-	
<b>VIII-4</b>	Declaration of inventorship (only for the purposes of the designation of the United States of America)	<b>1</b>	
<b>VIII-5</b>	Declaration as to non-prejudicial disclosures or exceptions to lack of novelty	-	

## PCT REQUEST

Original (for SUBMISSION )

VIII-2-1	<b>Declaration: Entitlement to apply for and be granted a patent</b> Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate: Name (LAST, First)	<b>in relation to this international application</b>  <b>OUTOKUMPU OYJ is entitled to apply for and be granted a patent by virtue of the following:</b>
VIII-2-1(i)		<b>OUTOKUMPU OYJ is entitled as employer of the inventor, HEIMALA, Seppo</b>
VIII-2-1(i)		<b>OUTOKUMPU OYJ is entitled as employer of the inventor, RUONALA, Mikko</b>
VIII-2-1(x)	<b>This declaration is made for the purposes of:</b>	<b>all designations except the designation of the United States of America</b>

## PCT REQUEST

Original (for SUBMISSION )

VIII-4-1	<p><b>Declaration: Inventorship (only for the purposes of the designation of the United States of America)</b> Declaration of Inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)) for the purposes of the designation of the United States of America:</p>	<p>I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.</p> <p>This declaration is directed to the international application of which it forms a part (if filing declaration with application).</p> <p>I hereby declare that my residence, mailing address, and citizenship are as stated next to my name.</p> <p>I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications", by application number, country or Member of the World Trade Organization, day, month, and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed.</p>
VIII-4-1-1	Prior applications:	20031083, FI, 17 July 2003 (17.07.2003)

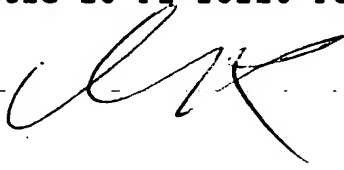
## PCT REQUEST

Paper Copy (NOT for submission)

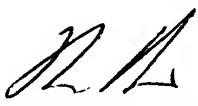
		<p>I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p>
VIII-4-1-1-1	Name (LAST, First)	HEIMALA, Seppo
VIII-4-1-1-2	Residence: (city and either US State, if applicable, or country)	Pori, Finland
VIII-4-1-1-3	Mailing address:	Marjastajantie 9 FI-28220 Pori Finland
VIII-4-1-1-4	Citizenship:	FI
VIII-4-1-1-5	Inventor's Signature: (if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent)	<i>Seppo Heimala</i>
VIII-4-1-1-6	Date: (of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)	<i>2 July 2004 (02.07.2004)</i>

## PCT REQUEST

Paper Copy (NOT for submission)

VIII-4-1-2-1	Name (LAST, First)	RUONALA, Mikko
VIII-4-1-2-2	Residence: (city and either US State, if applicable, or country)	Pori, Finland
VIII-4-1-2-3	Mailing address:	Lumimarjantie 16 FI-28220 Pori Finland
VIII-4-1-2-4	Citizenship:	FI
VIII-4-1-2-5	Inventor's Signature: (if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent)	
VIII-4-1-2-6	Date (of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)	2 July 2004 (02.07.04)

**PCT REQUEST**Original (for **SUBMISSION**)

<b>IX</b>	<b>Check list</b>	<b>number of sheets</b>	<b>electronic file(s) attached</b>
IX-1	Request (including declaration sheets)	8	✓
IX-2	Description	11	-
IX-3	Claims	2	-
IX-4	Abstract	1	✓
IX-5	Drawings	1	-
IX-7	TOTAL	23	
	<b>Accompanying Items</b>	<b>paper document(s) attached</b>	<b>electronic file(s) attached</b>
IX-8	Fee calculation sheet	✓	-
IX-9	Original separate power of attorney	✓	-
IX-17	PCT-SAFE physical media	-	✓
IX-19	Figure of the drawings which should accompany the abstract	1	
IX-20	Language of filing of the international application	Finnish	
X-1	Signature of applicant, agent or common representative	 <b>OUTOKUMPU OYJ, INTELLECTUAL PROPERTY MANAGEMENT</b> <b>Hannu Aarnio</b> <b>Manager, Patent Services</b>	
X-1-1	Name		
X-1-2	Name of signatory		
X-1-3	Capacity		

**FOR RECEIVING OFFICE USE ONLY**

10-1	Date of actual receipt of the purported international application	
10-2	Drawings:	
10-2-1	Received	
10-2-2	Not received	
10-3	Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application	
10-4	Date of timely receipt of the required corrections under PCT Article 11(2)	
10-5	International Searching Authority	ISA/SE
10-6	Transmittal of search copy delayed until search fee is paid	

**FOR INTERNATIONAL BUREAU USE ONLY**

11-1	Date of receipt of the record copy by the International Bureau	
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